UNITED STATES PATENT AND TRADEMARK OFFICE

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09/686,572	10/10/2000	Thomas James Dubil	US000183	4775

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U S Philips Corporation
Corporate Patent Counsel
580 White Plains Road
Tarrytown, NY   10591

EXAMINER
NGUYEN, NHON D

ART UNIT	PAPER NUMBER
2174	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
   Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 March 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-6,8 and 13-18* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-6, 8, and 13-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1. This communication is responsive to Amendment C, filed 03/29/2004.

2. Claims 2-6, 8, and 13-18 are pending in this application. Claims 13-18 are

independent claims. In the Amendment C, claims 1, 7, and 9-12 are canceled, claims 2-5

and 8 are amended, and claims 13-18 are added. This action is made non-final.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2-6, 8, 13, 14, 15, and 17 are rejected under 35 U.S.C. 112, first

paragraph, as failing to comply with the written description requirement. The claim(s)

contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention.

As per independent claims 13-15 and 17, the deliverability of the converted code

to an apparatus independent of a bi-directional network from which the control code is

obtained is not described in the specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-6, 8, and 13-18 rejected under 35 U.S.C. 112, second paragraph, as

failing to set forth the subject matter which applicant(s) regard as their invention.

Evidence that independent claims 13-18 fail to correspond in scope with that which

applicant(s) regard as the invention can be found in the reply filed 03/29/2004. In that

paper, applicant has stated "a control code in a mark-up language that is converted to an

IR or RF signal", and this statement indicates that the invention is different from what is

defined in the claim(s) because there is no conversion from a control code, which is in a

mark-up language format, to an IR or RF signal in independent claims 13-18.

7. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

The phrase "enabling a plurality of users to specify to a server for each user an

apparatus for being controlled by the control device of a user" is very confusing and hard

to understand. And the phrase "a user's control device for delivery of the control code to

the control device" does not make sense.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 13, 2, 3, and 14-17 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Yang (US 6,133,847) in view of Humpleman et al. ("Humpleman", US

6,546,419).

As per independent claim 13, Yang teaches a method, comprising:

over a bi-directional data network (fig. 5) providing, a control code (col. 7, line

52) to a home network comprising a control-device (remote control device 100 of fig. 5),

the control code being representative of an IR or RF command for controlling the state of

an apparatus (col. 3, lines 44-46);

the control code not being usable by an apparatus until the control code is

converted into the command and transmitted to the apparatus by an IR or RF signal that

is independent of the bi-directional data network over which the control code was

provided, wherein the apparatus is not pre-configured to deliver or cause delivery of its

respective control code to the control device (col. 7, lines 51-54);

enabling the home network to convert the control code into the IR or RF

command (col. 3, lines 44-46); and

enabling the control device to send the command to the apparatus (col. 8, lines 17-

25).

Yang does not disclose the control code comprising data in a mark-up language

format. Humpleman discloses that in col. 9, line 53 – col. 10, line 15. It would have been

obvious to an artisan at the time of the invention to use the teaching from Humpleman of

including a mark-up language format in the control code in Yang's system since it would

allow the system to easily integrate into the Internet/Web network.

As per claim 2, which is dependent on claim 13, Yang teaches the data is

provided via a data network (fig. 5, col. 7, lines 48-57).

As per claim 3, which is dependent on claim 2, Yang teaches:

Enabling a user to specify to a server on the network an apparatus for being

controlled by the control device; and enabling the server to identity a corresponding

control code for being provided as the data in the mark-up language format (col. 7, line

54 – col. 8, line 25).

As per independent claim 14, it is rejected under the same scope as claim 13.

As per independent claim 15, Yang teaches a data base, comprising:

control codes (col. 7, line 52) for controlling apparatuses through remote control

devices (remote control device 100 of fig. 5), the control codes representing IR or RF

commands (col. 3, lines 44-46) for transmission by the remote control devices to the

apparatuses (col. 8, lines 17-25), the database being in communication over a bi-

directional data network with a plurality home network systems each of which comprises

at least a remote control device (fig. 5), the control codes being deliverable to the remote

control devices independent of the controlled apparatuses (col. 7, lines 51-54).

Yang does not disclose the control codes being formatted in a mark-up language.

Humpleman discloses that in col. 9, line 53 – col. 10, line 15. It would have been obvious

to an artisan at the time of the invention to use the teaching from Humpleman of

including a mark-up language format in the control code in Yang's system since it would

allow the system to easily integrate into the Internet/Web network.

As per independent claim 16, Yang teaches a control code stored on a machine

readable medium for control of CE equipment (col. 7, lines 51-54), the control code

representing an IR or RF signal for transmission by a remote control device to the CE

equipment (col. 8, lines 17-25).

Yang does not disclose the control code being supplied in an XML format.

Humpleman discloses that in col. 9, line 53 – col. 10, line 15. It would have been obvious

to an artisan at the time of the invention to use the teaching from Humpleman of

including a XML format in the control code in Yang's system since it would allow the

system to easily integrate into the Internet/Web network.

As per independent claim 17, Yang teaches a method comprising:

over a bi-directional data network, enabling a plurality of users to specify to a

server for each user an apparatus for being controlled by the control device of a user; and

enabling the server to identify a control code, the control code being representative of a

control code for an apparatus (col. 7, line 54 – col. 8, line 25); and

enabling the server to communicate over the bi-directional data network with a

home network that comprises a user's control device for delivery of the control code to

the control device (col. 7, lines 51-54), wherein the control code is not directly usable by

the specified apparatus until conversion by the home network into a command that can be

sent by the control device independent of the bidirectional network (col. 8, lines 17-25).

Yang does not disclose the control code comprising data in a mark-up language

format. Humpleman discloses that in col. 9, line 53 – col. 10, line 15. It would have been

obvious to an artisan at the time of the invention to use the teaching from Humpleman of

including a mark-up language format in the control code in Yang's system since it would

allow the system to easily integrate into the Internet/Web network.

10. Claims 18 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Yang in view of Humpleman and further in view of Jackson (US 5,963,264).

As per independent claim 18, Yang teaches a method, comprising:

providing control codes to a home network comprising a control device for

installation on the control device, and one set of control codes representing IR or RF

signals (col. 3, lines 44-46) for transmission by a remote control device to the CE

equipment to control the state of the equipment (col. 8, lines 17-25), the control codes

being provided from a database over a bi-directional data network to the home network

(col. 7, lines 51-54).

Yang does not disclose data representative of a control code provided in a mark-

up language format. Humpleman discloses that in col. 9, line 53 – col. 10, line 15. It

would have been obvious to an artisan at the time of the invention to use the teaching

from Humpleman of providing data representative of a control code in a mark-up format

in Yang's system since it would allow the system to easily integrate into the Internet/Web

network.

The modified Yang does not disclose another set of control code is part of an EPG

or ECG. Jackson discloses that in col. 2, lines 47-50. It would have been obvious to an

artisan at the time of the invention to use the teaching from Jackson of having the control

code as part of an EPG or ECG in modified Yang's system since it would allow the

control device to control an apparatus and to navigate through its EPG using the same

remote control device.

As per claim 4, which is dependent on claim 13, modified Yang does not disclose

the control code is part of an EPG or ECG. Jackson discloses that in col. 2, lines 47-50. It

would have been obvious to an artisan at the time of the invention to use the teaching

from Jackson of having the control code as part of an EPG or ECG since it would allow

the control device to control an apparatus and to navigate through its EPG using the same

remote control device.

11. Claims 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Yang in view of Humpleman and further in view of Mitani (US 6,466,233).

As per claims 5 and 6, which are dependent on claims 13 and 5, respectively,

modified Yang does not teach supplying a GUI element for use on the control device, the

GUI element being supplied as further data in the mark-up language format and the GUI

element comprises a graphical representation of a remote control device. Mitani teaches

supplying a GUI element for use on the control device, the GUI element being supplied

as further data in the mark-up language format (fig. 2; col. 4, lines 48-60) and the GUI

element comprises a graphical representation of a remote control device (fig. 9; col. 6,

lines 66-67 through col. 7, lines. 1-19). It would have been obvious to an artisan at the

time of the invention to use the teaching from Mitani of supplying a GUI element for use

on the control device, the GUI element being supplied as further data in the mark-up

language format and the GUI element comprises a graphical representation of a remote

control device in modified Yang's system since it would allow the use of a remote

control device without a need for a separate monitor display device.

As per claim 8, which is dependent on claim 14, it is rejected under the same

rationale as claim 5.

Response to Arguments

12. Applicant's arguments filed 03/29/2004 have been fully considered but they are

not persuasive.

Applicants argued the following:

(a) Yang fails to recite the claim limitation of a control code in a mark-up

language that is converted to an IR or RF signal.

(b) Yang fails to recite the claim limitation of the deliverability of the converted

code to an apparatus independent of a bi-directional network from which the control code

is obtained.

(c) The rejection is traversed because there is no teaching, suggestion, or

motivation found in the references for their combination (between Yang and

Humpleman) assuming arguendo that all limitations were present.

The Examiner disagrees for the following reasons:

(a) Independent claims 13-18 do not specifically recite the claim limitation of "a control code in a mark-up language that is converted to an IR or RF signal". Therefore, the claim language of claims 13-18 still can be interpreted that the control code comprises data in mark-up language (or XML) format, which is taught by Humpleman at col. 9, line 53 – col. 10, line 15, and also comprises IR or RF command for controlling the state of an apparatus, which is taught by Yang at col. 3, lines 44-46.

(b) According to Yang, when the programming code is transmitted from the remote control device 100 to the apparatus 510, 520, 530, and 540 of fig. 5, it is not constrained or controlled by the bi-directional network 150 (col. 8, 18-25); therefore, it is clearly that the deliverability of the converted code to an apparatus is independent of a bi-directional network from which the control code is obtained.

(c) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Yang and Humpleman teach a control system used to send control and command data from a control device to control a plurality of electronic appliances. Therefore, It would have been obvious to an artisan at the time of the invention to use the teaching from Humpleman of including a mark-up language format in the control code in Yang's system since it would allow the system to easily integrate into the Internet/Web network.

Inquiries

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon (Gary) D Nguyen whose telephone number is 703-305-8318. The examiner can normally be reached on Monday - Friday from 8 AM to 5:30 PM with every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L Kincaid can be reached on 703-308-0640. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nhon (Gary) Nguyen
June 10, 2004

KRISTINE KINCAID
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100